



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/857,100	05/15/97	NEVILL	660073.555

JOHN C STEWART  
SEED AND BARRY  
6300 COLUMBIA TOWER  
701 FIFTH AVENUE  
SEATTLE WA 98104-7092

MM51/0821

EXAMINER
STCYR,D

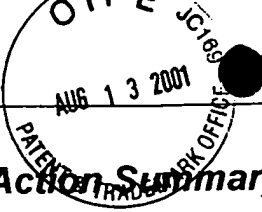
ART UNIT	PAPER NUMBER
2876	

DATE MAILED: 08/21/98

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Office Action Summary**



Application No.

08/857,100

Applicant(s)

Leland R. Nevill

Examiner

Daniel St.Cyr

Group Art Unit

2876



☒ Responsive to communication(s) filed on May 15, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claim**

☒ Claim(s) 1-18 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-18 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

**Application Papers**

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## DETAILED ACTION

### *Claim Rejections - 35 U.S.C. § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-15 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Yokokawa, US Patent No. 4,904,853.

Yokokawa discloses a dual-function information carrying sheet device comprising : a programmable integrated circuit 26 containing electronic data therein; and a visual information 32 recorded on the sheet wherein the electronic data is associated with the visual optical data stored in the medium. (See figures 1-3; col. 3 lines 16-64).

Re claims 3 and 9, the method of associating the electronic data with the optical data is inherently including the step of accessing a look-up table in order to verify that the two data are indeed the same.

Re claims 4 and 12, a plurality of programmable links may be used, such as ROM, EEPROM, etc. (See col. 5, lines 11-18).

Re claim 5, a glue is used for placing an adhesive label on the integrated circuit. (See col. 10, lines 1-7).

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Re claim 6, wherein the marking of the integrated circuit is done by inscribing a symbol on the integrated circuit.

Re claim 15, the contacts 28 connect to the housing for providing electrical connection between the integrated circuit and circuitry external to the housing (see col. 3, lines 33- 63).

***Claim Rejections - 35 U.S.C. § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yokokawa.

The teachings of Yokokawa have been discussed above.

Yokokawa does not specifically disclose a second optical mark carrying the same identification data, but the area of the optical data of Yokokawa is fairly large which can easily incorporate a larger optical image or a multiple of smaller optical images. Furthermore, having a second optical mark carrying the same identification data is a duplication of elements. Therefore, it would have been obvious to duplicate the identification data.

***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Doederlein et al, US Patent No. 5,641,164, disclose a talking trading card. Voshell et

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al, US Patent No. 5,742,526, disclose an apparatus and method for identifying an integrated device. Welander, US Patent No. 5,743,801, discloses a collectable video sport card. Shepherd, US Patent No. 5,748,731, disclose electronic trading cards.

Papers related to this application may be submitted to Technology Center 2800 by facsimile transmission. Papers should be faxed to Technology Center 2800 via PTO fax machine located at Crystal plaza 4. The fax number is (703)308-7722.

Any inquiry concerning this communication from the examiner should be directed to **Daniel St.Cyr** whose telephone number is (703) 305-2656. The examiner can normally be reached between the hours of 8:00AM to 4:30PM Monday to Thursday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Anita Pellman Gross**, can be reached at (703) 308-4869.

Any inquiry of general nature relating to the status of this application should be directed to the group receptionist whose telephone is (703)308-0956.



August 12, 1998

DS

  
ART UNIT 2876  
TFF/EN/LE

**Notice of References Cited**

Application No.  
**08/857,100**

Applicant(s)

**Leland R. Nevill**

Examiner

**Daniel St.Cyr**

Group Art Unit

**2876**

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**U.S. PATENT DOCUMENTS**

	DOCUMENT NO.	DATE	NAME	CLASS	SUBCLASS
A	4,904,853	02/27/90	Yokokawa	235	487
B	5,641,164	06/24/97	Doederlein et al	273	237
C	5,742,526	04/21/98	Voshell et al	235	380
D	5,743,801	04/28/98	Welander	463	43
E	5,748,731	05/05/98	Shepherd	380	4
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**FOREIGN PATENT DOCUMENTS**

	DOCUMENT NO.	DATE	COUNTRY	NAME	CLASS	SUBCLASS
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**NON-PATENT DOCUMENTS**

	DOCUMENT (Including Author, Title, Source, and Pertinent Pages)	DATE
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FORM PTO-1449  
(REV. 7-80)U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICEATTY. DOCKET NO.  
660073.555APPLICATION NO.  
08/857,100INFORMATION AND CLOSURE STATEMENT  
(Use several sheets if necessary)APPLICANT  
Leland R. NevillFILING DATE  
May 15, 1997GROUP ART UNIT  
2514

## U.S. PATENT DOCUMENTS

INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
DS	AA	4,967,381	10/30/90	Lane et al.	364	551.01	
DS	AB	5,103,166	04/07/92	Jeon et al.	324	158 R	
DS	AC	5,226,118	07/06/93	Baker et al.	395	161	
DS	AD	5,294,812	03/15/94	Hashimoto et al.	257	65	
DS	AE	5,301,143	04/05/94	Ohri et al.	365	96	
DS	AF	5,380,998	01/10/95	Bossen et al.	235	494	
DS	AG	5,389,770	02/14/95	Ackley	235	462	
DS	AH	5,420,796	05/30/95	Weling et al.	364	468	
DS	AI	5,467,304	11/14/95	Uchida et al.	365	174	
DS	AJ	5,511,005	04/23/96	Abbe et al.	364	552	
	AK						

## FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION	
							YES	NO
	AL							
	AM							
	AN							
	AO							
	AP							

## OTHER PRIOR ART (Including Author, Title, Date, Pertinent Pages, Etc.)

	AR		
	AS		

EXAMINER

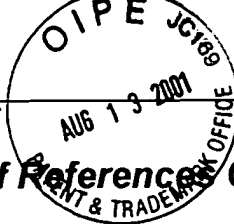
DATE CONSIDERED

Daniel St. Ger

8/11/98

\* EXAMINER: Initial if reference considered, whether or not criteria is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant(s).

**Notice of References Cited**



Application No.  
**08/857,100**

Applicant(s)

**Leland R. Nevill**

Examiner

**Daniel St.Cyr**

Group Art Unit

**2876**

Page 1 of 1

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	DOCUMENT NO.	DATE	NAME	CLASS	SUBCLASS
A	4,904,853	02/27/90	Yokokawa	235	487
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C	5,742,526	04/21/98	Voshell et al	235	380
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E	5,748,731	05/05/98	Shepherd	380	4
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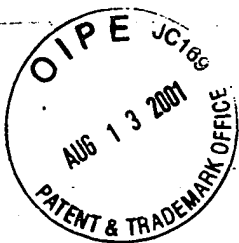
**FOREIGN PATENT DOCUMENTS**

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**NON-PATENT DOCUMENTS**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/857,100	05/15/97	NEVILL	L 660073.555

EXAMINER
ST CYR, D

ART UNIT	PAPER NUMBER
2876	

DATE MAILED: 02/25/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Office Action Summary**



Application No. <b>08/857,100</b>	Applicant(s) <b>Leland R. Nevil</b>
Examiner <i>Diane Lee</i>	Group Art Unit <b>2876</b>

☒ Responsive to communication(s) filed on Nov 30, 1998

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**

☒ Claim(s) 1-25 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-25 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

**Application Papers**

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on Nov 30, 1998 is ☒ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### DETAILED ACTION

1. Receipt is acknowledged of the Amendment filed on November 30, 1998 in which claims 1-18 were amended and claims 19-25 were added.

#### *Claim Rejections - 35 U.S.C. § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larson et al, US Patent No. 5,360,747 in view of Aurenus.

Larson et al disclose a method for reducing dice testing with on-chip identification comprising: identifying a plurality of dice 100-199, 200-299, and 300-399, including IC chips therein, formed on a common semiconductor substrate (wafer) W1, W2, and W3, wherein each semiconductor includes a plurality of programmable links (ID cells 7). Each die (IC) is programmed through a link (ID cells 7) with a respective electronic identification. The information of each die is stored on file as to form a look up table. (See col. 3, lines 22-52).

Larson et al fail to show or fairly suggest a housing wherein electrical contacts are connected to the housing to provide electrical contact between the integrated circuit and circuitry external the housing and fail to suggest that each integrated circuit includes an optical mark for

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identifying the integrated circuit wherein the mark is identical to the electronic information stored in the programmable link.

Aurenus et al disclose a microlabelling system and method of making thin label. Aurenus et al disclose a microlabel 40 carrying indicia 46 disposed on an individual die 44 during probing and quality control process wherein the indicia contains information related to the specified die (see col. 10, lines 53-63). Aurenus et al show a housing 126 having an optical mark 122 thereon and having electrical contacts connected to the housing to provide electrical contact between the integrate circuit therein and circuitry external the housing (see figure 8). Aurenus et al also disclose that the optical mark on top on the housing carries the information contained on top of the internally-carried die (see col. 13, lines 3-8).

It would have been obvious for a person of ordinary skill in the art to employ the teachings of Larson et al in conjunction with the teaching of Aurenus et al for the purpose to further reduce dice testing. Having an optical mark on the surface of each die would eliminate unnecessary probe testing time because all dice would be coded with the information on the surface of the dice for identification. Such modification would further reduce wafer testing which would reduce wear and tear on the test probe. Therefore, such modification would have been an obvious expedient within the ordinary skill in the art.

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*Conclusion*

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tuttle, US Patent No. 5,787,174, discloses a remote identification of interface circuit. Shaw et al, US Patent No. 5,801,067, disclose a method for recording and identifying integrated circuit chips and the like.
5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Daniel St-Cyr** whose telephone number is (703) 305-2556. The examiner can normally be reached between the hours of 7:00AM to 4:30PM Monday thru Thursday and every other Friday (first Friday of the bi-week).  
-2656

Art Unit: 2876

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Donald T. Hajec**, can be reached on (703) 308-4075. The fax phone number for this Group is (703)308-5841 or (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

*[Signature]*  
THIEN LE  
ART UNIT 2876

DS

*[Signature]*  
January 31, 1999



# Notice of References Cited

Application No. <b>08/857,100</b>	Applicant(s) <b>Leland R. Nevil</b>
Examiner <i>Donald St. Cyr</i> <b>Diana Lee</b> <i>2/10/05</i>	Group Art Unit <b>2876</b>

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## U.S. PATENT DOCUMENTS

	DOCUMENT NO.	DATE	NAME	CLASS	SUBCLASS
A	5,129,974	06/14/92	Aurenius	283	81
B	5,360,747	11/01/94	Larson et al	437	8
C	5,787,174	07/28/98	Tuttle	380	23
D	5,801,067	09/01/98	Shaw et al	438	15
E					
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## NON-PATENT DOCUMENTS

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